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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,423	11/03/2003	Clark Easter	026063-00018	1510

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ARENT FOX PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER	
SMITH, TRACI L	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/698,423	EASTER ET AL.	
	Examiner	Art Unit	
	Traci L Smith	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-39 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-39 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim36-39 objected to because of the following informalities: The claims are dependent on Claim 19 which is a system, however the dependent claims state "A method of claim 19" Applicant is asked to make corrections either making the claims depend from a method or re-write in proper form.. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-18 and 32-37 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant claims several mathematical processes such as calculations, factoring and variances that are not disclosed in the specification so as one skilled in the art would be able to make and/or use the system.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim1-18 and 32-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

6. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

7. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable

subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

8. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

9. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the

"technological art" because the claimed invention was an operation being performed by a computer within a computer.

10. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

11. Claims **1-18 and 32-35** appear to be describing a method that is **attempting to determine a type and number of services in a date range for an IEP.** Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.

12. **The applicants amended claims with the electronic process are not enough to distinguish that the steps are being performed by a computer processor, "determining electronically" can merely be a calculator. All of the dependent claims could all be performed by human intervention.**

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-39 rejected under 35 U.S.C. 103(a) as being unpatentable over www.4nlsoftware.com; any linkage', *March 03, 2001 ; retrieved from the wayback machine on August 25, 2004 hereinafter referred to as 4GL in view of US Patent 6270351 B1 Roper

As to claims **1, 19 and 31** 4GL teaches a method, system and program of receiving dates (Pg. 1. 6).

Identifying service plans within the date range (pg. 5 1. 11)

Identifying encounters within the plan(pg. 5 1. 7).

4GL fails to teach an automatic way to determine Roper teaches a tracking IEP database and automatically creating new IEP's. (C. 6 l. 3-5). It would have been obvious to one skilled in the art to combine the teachings of 4GL with Roper so as to allow schools and administrators to maintain an organized and structured method of complying with federal education laws.

As to claim **2** 4GL teaches a method with individual education plans(IEP)(Pg. 5 1. 11).

As to claims **3 and 10** 4GL teaches a method comparing expected service with identified encounters. (Pg. 5 1. 21-23).

As to claim **4** 4GL teaches a method of producing a number of shortfall or surplus encounters (Pg. 14 1. 5-6)

As to claim **5** 4GL teaches a method of comparing expected numbers with identified numbers. (Pg. 14 1. 6-7)

As to claims **6, 9 and 11** 4GL teaches a method of a result of shortfall or surplus of services. (Pg. 14 1. 10-13)

As to claim **7** 4GL teaches a method of dividing a date range into a time period. (Pg. 14 1. 29)

As to claim **8** 4GL teaches a method of comparing expected and identified numbers from one time period to another. (Pg. 15 1. 13-15)

As to claim **12** teaches a method of tracking an encounter that is reported late. (pg. 5 1. 13)

As to claim **13** 4GL teaches a method of providing dates encounters took place. (Pg. 5 1. 19-20)

As to claims **14-16** 4GL teaches a method for entering and storing information regarding encounter types and encounters associated with an individual service plan and provider. (Pg. 8 1. 12-16 & p. 9 1.6-8).

As to claim **17** 4GL teaches a method with encounters of missed services (Pg.5 1. 14-15).

As to claim 18 4GL a method of storing the information resulting from an encounter. (Pg. 7 1. 21-23).

As to claim **20** 4GL teaches a system for compliance management with a processor, user interface and database. (Pg. 18 1. 1-5).

electronic forms identical to paper forms so that personnel know how to fill them out on a computer that gets saved on the database. (Pg. 9 1.5-3 & 13)

IEP forms pull from banks of goals and objectives and compliance checking using the forms the user fills out to determine other information about encounters (Pg. 9. 1-2 & 6-8)

As to claim **21** 4GL teaches system with a terminal NT platform (Pg. 15 1. 33-34)

As to claims **22 and 24** 4GL teaches a system with a PC. (Pg. 18 1.9-10)

As to claim **23** 4GL teaches a system with a processor housed in a server (p9. 18 1. 6)

As to claims **25 and 30** 4GL teaches a system with a server coupled to a

network (Pg. 19 1. 1)

As to claim **26** 4GL teaches a system with a network as the internet. (Pg. 19 1. 18-19)

As to claim **27 and 28** 4GL teaches a system with a server and a networking system. As to this being "coupled", coupling is inherent in any networked computer system.tpg. 19 1. 1 and 17-20)

As to claim **29** 4GL teaches a system with a server to store the database. (Pg. 19 1. 12)

As to claims **32 and 36** 4GL teaches a system and method for tracking and reporting an individuals IEP encounters. However, 4GL fails to teach calculating duration services. Roper teaches a system and method for determining a students qualifications that are specifically designed for a certain threshold based on standard scores.

As to claims **33** and **37** 4GL teaches a system and method for identifying services for an IEP, however, 4GL fails to teach converting encounters to a common unit of measurement. Roper teaches a score conversion which puts all test scores in a common unit.(Fig. 23 C. 11 l. 67). It would have been obvious to one skilled in the art at the time of invention to combine the teachings of 4GL with Roper as to make it a logical, easy and accurate comparison by having the encounters all in the same type of measurement.

As to claims 34-35 and 38-39 4GL teaches determing services required by an individuals IEP in a school year. Althought 4GL does not explicitly teach a calendar and that calendar being a school calendar, it is understood to require a calendar in order to determine if the services frequency fall on days when school is in session and if there are providers available to perform these service. It is obvious to anyone who is

planning or setting a schedule of events to consult the appropriate calendar while making these types of decisions.

Response to Arguments

Applicant's arguments with respect to claim 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tls

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600